UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: February 8, 2006

Opposition No. **91161969**

The Ritz-Carlton Hotel Company, LLC

v.

Robert B. Wilcox

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of opposer's motions (both filed August 19, 2005) to compel discovery and to reset testimony periods. The motions have been fully briefed.

The Board turns first to opposer's motion to compel. In support thereof, opposer contends that applicant's responses to opposer's first set of interrogatories were unverified and signed by applicant's attorney and not by applicant himself. Opposer further contends that certain of applicant's responses to individual interrogatories are inadequate.

In response, applicant contends that it believes that its discovery responses are adequate, but that it will provide verified responses that are signed by applicant

himself and will supplement his interrogatory responses, if necessary.

As an initial matter, the Board finds that opposer made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. See Trademark Rule 2.120(e)(1). However, the Board notes that, while opposer has alleged that applicant's responses to interrogatory nos. 3, 7, 12, 14, and 28 are incomplete, opposer has cited to no case law in its brief to support its contention that all the information sought by these interrogatories is properly discoverable. See TBMP Section 414 regarding the discoverability of various types of information in Board *inter partes* proceedings.

With regard to applicant's attorney answering opposer's first set of interrogatories, interrogatories must be answered by the party served. See Fed. R. Civ. P. 33(a); TBMP Section 405.04(c). Further, interrogatory answers must be made separately and fully, in writing under oath. See Fed. R. Civ. P. 33(b)(1); TBMP Section 405.04(b). Accordingly, applicant is directed to serve amended answers to opposer's first set of interrogatories that are executed by himself under oath.

The Board turns next to the content of the responses at issue in the individual interrogatories at issue in opposer's motion. Opposer's interrogatory no. 3 seeks

information regarding the "acquisition, selection, availability, adoption, creation, design, decision to use, intent to use, attempt to register, and/or registration of Applicant's Mark." This information is discoverable. See *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974); TBMP Section 414(4) (2d ed. rev. 2004). Applicant's response that he and his spouse selected the mark for no specific reason is incomplete. Applicant is directed to serve a complete response to interrogatory no. 3.

Opposer's interrogatory no. 7 seeks information regarding "all persons who designed, created, printed, or made each item on which Applicant's Mark has ever been displayed," including advertising and promotional materials. The Board notes however, that applicant's involved application to register the word mark RITZ is for "art galleries offering original and limited edition fine art, namely, paintings, photographs, sculptures and prints" in International Class 35 only. To the extent that opposer seeks information about any goods on which the involved mark is used, applicant need not provide discovery with respect to any marks and goods and/or services that are not involved in this proceeding. See *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 n.2 (TTAB 1985); TBMP Section 414(11) (2d ed. rev. 2004). To the extent that

opposer seeks information about advertising and promotional materials for the involved mark as intended to be used on the services recited in the involved application, opposer's request for all such persons is unduly burdensome. See Fed. R. Civ. P. 26(b)(2). Rather, the Board finds that opposer's discovery needs with regard to this interrogatory can be met by applicant's identification of the persons most knowledgable of the design and creation of advertising and promotional materials for the involved mark as intended to be used in connection with the services set forth in the involved application. As such, applicant's response that he and his spouse worked jointly on the design is acceptable.

Opposer's interrogatory no. 12 seeks information regarding "all advertising and promotional methods, or types of media, used or intended to be used in advertising or promoting the sale of any products or services under Applicant's Mark." Inasmuch as the information sought goes to the trade channels of applicant's involved services, that information is discoverable. See TBMP Section 414(3) (2d ed. rev. 2004). However, to the extent that opposer seeks information regarding advertising and promotion of the mark for goods and services not at issue in the involved application, this interrogatory is overly broad. See TBMP Section 414(11) (2d ed. rev. 2004). Applicant's response that it has not used the mark is unresponsive. Applicant is

directed to respond to interrogatory no. 12 by identifying the methods and types of media that applicant intends to use to advertise and promote the services recited in the involved application under the involved RITZ mark.

Opposer's interrogatory no. 14 asks applicant to "[i]dentify the types of prospective purchasers or customers who have used or purchased, or who may use or purchase, the products and services in connection with which Applicant's Mark is used." The plain language of this interrogatory is limited to seeking information regarding "the products and services in connection with which Applicant's Mark is used." Because the involved application is based on an assertion of a *bona fide* intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), applicant's response that he has not used the involved mark with any product or service to date is acceptable.

Opposer's interrogatory no. 28 seeks information regarding objections that applicant has received to the use and registration of its involved mark, specifying the identity of each person from whom any such objection was received, the date of that objection and action taken in response thereto. With regard to objections by third parties, applicant's response that "[n]o such third party objections exist" is acceptable. To the extent that opposer seeks information regarding opposer's own objection to

applicant's use and registration of the involved mark, information regarding the identity of each person from whom any such objection was received and the date of such objection, and any correspondence from applicant to opposer in response thereto is more conveniently obtained from opposer's own records. See Fed. R. Civ. P. 26(b)(2); TBMP Section 414(10) (2d ed. rev. 2004). Applicant is directed to supplement its response to this interrogatory by identifying actions taken in response to opposer's objections to applicant's use and registration of the involved mark other than those set forth in correspondence to opposer.

In view thereof, opposer's motion to compel is hereby granted in part and denied in part. To the extent that applicant has not done so already, applicant is allowed until thirty days from the mailing date of this order to serve properly verified responses to opposer's first set of interrogatories and supplemental responses to opposer's interrogatory nos. 3, 12, and 28.[1]

Opposer's motion to reset testimony periods is hereby granted. Proceedings herein are resumed. Discovery remains closed. Trial dates are reset as follows.

Plaintiff's 30-day testimony period to close: **4/28/06**

[1] If respondent fails to comply with this order, petitioner's remedy lies in a motion for discovery sanctions under Trademark Rule 2.120(g)(1).

Defendant's 30-day testimony period to close: **6/27/06**

Plaintiff's 15-day rebuttal testimony period to close: **8/11/06**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.